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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
10 039,783	11 09 2001	Steven E. Morton	EC61X 104	9088

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KREMBLAS, FOSTER, PHILLIPS & POLLOCK  
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REYNOLDSBURG, OH 43068

EXAMINER

PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 06 06 2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/039-783

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 4/2/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-42 is/are pending in the application.
- Of the above claim(s) 4-13, 19-34, 36-42 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-3, 14-18, 35 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of claims 1-28, 35 in Paper No. 4 is acknowledged. Regarding the election of species, Applicant erroneously stated claims 5 and 20, which are separate and unrelated species as set forth in the Office restriction, are readable on elected specie 3. Claims 5 and 20 are therefore not examined. Further, claim 18 was grouped with claim 3 in the Office restriction, and therefore will be examined. Therefore claims 1-3,14-18,35 are examined.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagin US 3334555.

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Nagiri teaches paving solid concrete surfaces, the embodiment illustrated by figure 4 comprising applying to concrete base 15 an underlayer 16 of epoxy with sheet or strand of fibers, applying thereon a layer 17 made of epoxy with abrasive grains, and curing to harden. In addition, fibers, either as a fabric, mat, or loose layer, may be placed upon the underlayer 16 to provide continuous reinforcement. Col. 2, 37-54; col. 5, 40-63.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 14,15,17,18,35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagin et al in view of Te'eni US 5543188.

Nagin et al is cited for the same reasons discussed above, which are incorporated herein. Interposing a membrane between substrate and coating is not cited.

Te'eni teaches to provide a flexible, corrosion protecting, and waterproofing membrane to surfaces of cement mortar or concrete surfaces, onto which is applied additional cementitious materials 18. The membrane comprises a polymeric sheet 14, e.g. PVC.

Since Nagin et al is also directed to applying coatings onto cement or concrete surfaces while substantially eliminating the "erratic performances" of such coatings described in column 1, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Nagin et al by incorporating the membrane of Te'eni to provide the recognized advantages of waterproofing and corrosion protection. Since the membrane prevents migration of water and corrosive species, it would also

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have necessarily prevented the liquid coating applied thereon from reaching, and adhering to, the substrate material.

7. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagin et al in view of Te'eni US 5543188 and further in view of Osborn et al US 4221697.

Nagin et al and Te'eni cited for the same reasons discussed above, which are incorporated herein. A membrane in the form of a release agent is not cited.

Osborn teaches forming a composite from a liquid polymeric liquid and abrasive particles in a molding process, and includes an external release agent to prevent adhesion of the hardened composite to surfaces and obtain a good surface finish.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Nagin et al in view of Te'eni by incorporating the release agent of Osborn in place of the membrane of Te'eni to provide the recognized advantages of preventing adhesion and good surface finish.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred J. Parker whose telephone number is (703) 308-3474.

A handwritten signature in black ink, appearing to read 'Fred J. Parker', is written over a horizontal line.

Fred J. Parker

June 5, 2003

10-039783

**FRED J. PARKER**  
**PRIMARY EXAMINER**